1652

#7
8/13/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Krzysztof B. Wicher, Olof Peder Holst, Maher Youssef Abou Hachem, Eva Margareta Nordberg Karlsson and Gudmundur O. Hreggvidsson
Application No.:	10/003,759 Group Art Unit: 1652
Filed:	October 23, 2001 Examiner: Manjunath N. Rao
For:	THERMOSTABLE CELLULASE

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Assistant Commissioner for Patents, P.O. Box 2327, Arlington, VA 22202

on August 2, 2002 (Date) Stephanie L. Carta (Signature)

Stephanie L. Carta
Typed or printed name of person signing certificate

REPLY TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
P.O. Box 2327
Arlington, VA 22202

Sir:

Responsive to the Restriction Requirement dated July 2, 2002, the claims of Group I (Claims 1-22) drawn to polynucleotides encoding a thermostable cellulase, vectors and host cells and methods of making the polypeptides are elected for prosecution. The election is being traversed. Applicants reserve the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected invention. Applicants do not hereby abandon or waive any rights in the non-elected invention.

Applicants traverse the Restriction Requirement on the grounds that both Groups, as defined by the Examiner, do not represent distinct inventions. Specifically, Applicants propose that the claims of Group I be rejoined with the claims of Group II (Claims 23 to 29) drawn to methods of producing an active variant of a glycosyl hydrolase. Reasons for the request of rejoinder are detailed below.

Applicants note that a similar set of claims were presented in parent application No. 09/594,884. The only restriction in the parent application was a two way restriction between polypeptides and polynucleotides. Thus, Claims drawn to polynucleotides encoding a thermostable cellulase, vectors and host cells and methods of making the polypeptides (Group 1 of the subject application) and claims drawn to methods of producing an active variant of a glycosyl hydrolase (Group 2 of the subject application) were searched and examined in the parent application. Note that the Examiner handling the parent prosecution is the same Examiner handling the subject application. He should be estopped from asserting that the subject claims, which are similar to the examined claims of the parent case, are separate and distinct and thus require restriction.

Additionally, even if the Examiner maintains the restriction, United States Patent Office Procedure dictates that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." See M.P.E.P. § 803. As is noted above, the Claims of Group II are method claims to produce the composition claims of Group I, so the invention of Group I would be searched in the scope of searching the invention of Group II. Thus, all claims of Group I and Group II should be examined on the merits, because to do so would not constitute a serious burden. Moreover, the Examiner did not find there to be a burden when the parent application was searched. There cannot be a burden now. Since the subject matter being elected is the same as the parent, the earlier search can be relied upon.

In view of the remarks above, reconsideration and withdrawal of the restriction are respectfully requested.

Information Disclosure Statement

An Information Disclosure Statement (IDS) was filed on October 23, 2001 and a Supplemental IDS was filed on April 26, 2002. Entry of the IDS, SIDS and return of an initialed copy of the 1449 forms are respectfully requested.

CONCLUSION

In summation, Applicants respectfully request the claims of Group I and Group II be rejoined. Should the Examiner believe that prosecution of the application may be expedited by a telephone conference with the Applicants' Agent, please call the undersigned at the number given below.

Respectfully submitted,
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Pamela A. Torpey

Pamela A. Torpey
Registration No. 45,736
Telephone: (978) 341-0036
Facsimile: (978) 341-0136

Concord, MA 01742-9133
Dated: August 2, 2002